

Appl. No. 10/614,352  
Amendment Dated December 22, 2008  
Reply to Office Action of August 21, 2008

Remarks:

Reconsideration of the application is requested. Claims 1-3, 8, 10-21, and 24-26, 28, and 30-40 are now in the application. Claims 1-2, 11-12, 17-21, and 24 have been amended. Claims 27 and 29 has been canceled. Claims 30-40 have been added.

Support for the amendments to claims 1, 21, 24, and 29 can be found in paragraph [0032].

Support for new claims 30 and 32 can be found in paragraph [0033] of the specification.

35 USC § 112

In item 2 of the Office action, the Examiner rejected claims 1 and 29 as being indefinite because the term, “said abutting location” lacked antecedent basis. Claims 1 has been amended; claim 29 has been canceled. The phrase has been deleted from the claim.

Accordingly, the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further rejectable items, counsel would appreciate a telephone call during which the matter may be resolved. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

35 USC § 102

In item 4 of the Office action, the Examiner rejected claims 1-3, 8, 10-11, 18-20, and 29 as being anticipated by Adams '552 under 35 USC § 102(e). The rejection has been noted and the claims have been amended in an effort to define more clearly the invention of the instant application. Support for the changes is found in paragraph [0032] and Fig. 2 of the specification.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Amended claim 1 calls for, *inter alia*, an implant including the following features:

a body portion ...; and

a pointed end portion ...;

said body portion and said end portion having a second passage formed therethrough transverse to the longitudinal central axis for threading the suture therethrough. (Emphasis added by Applicant.)

Adams '552 (especially Fig. 1) only shows compression clips (100) with holes (104) formed in the body portion (101). No holes are formed in the pointed end portion (105).

Accordingly, the reference does not show a "body portion and ... end portion having a second passed formed therethrough" as recited in claim 1 of the instant application. Therefore, claim 1 is not anticipated by Adam '552. Likewise, the claims that depend on claim 1 also are not anticipated.

Claims 2-3, 8, and 10-20 ultimately depend on claim 1 and are novel for the same reasons as claim 1.

35 USC § 103(a)

In item 6 of the Office action, the Examiner rejected claims 12-17 as being unpatentable over Adams '552 under 35 USC § 103(a).

As amended, claims 12-17 ultimately depend on claim 1. Claims 12-17 are not-obvious for the reason discussed below with regard to claim 1.

Amended claim 1 teaches *inter alia* an implant with the following features:

a body portion ... having a first passage extending therethrough orthogonal to the longitudinal central axis which allows for the threading of suture; and

a pointed end portion ...;

said body portion and said pointed end portion having a second passage extending therethrough orthogonal to the longitudinal central axis for threading the suture therethrough. (Emphasis added by Applicant.)

Adams '552 teaches a compression clip (Fig. 1) with holes (104) formed in the body portion (101). A pointed end portion (105) is included but has no holes formed therethrough.

The passages (105) in Adams '552 are for engaging the flap (107) of the bolster (106). Because the bolster would not be pushed as low (i.e. toward the anchor (105) as the anchor (105), Adams '552 does not suggest a passage being formed in the anchor (105).

In contrast, the invention according to claim 1 describes a fastener that is inserted into tissue and then is tilted by pulling a suture that is inserted through the passages in the fastener. Forming a passage in the tip allows the fastener to be tipped earlier in the insertion process than fasteners with more distally placed passages.

Accordingly, Adams '552 does not suggest all of the features of the invention described in claim 29. Therefore, claims 12-17, which depend on claim 1, are also patentable.

In item 7 of the Office action, the Examiner rejected claims 21 and 26-27 as being unpatentable over Adams '552 in view of Whittaker '712 under 35 USC § 103(a).

Amended claim 21 ultimately depends on claim 1 and is patentable over the prior art for the same reasons as claim 1.

Whittaker et al. '712 does not teach or suggest a fastener with a passage transversing the substantially conical end portion. Whitaker et al. '712 teaches an anchor where a passage reaches the conical section. However, the passage in Whitaker et al. emerges at the body portion, not the conical end portion. As discussed, having the suture emerge at the conical edge portion has the advantage of being able to tilt the anchor sooner during the insertion process. This advantage is not taught or suggest by Whittaker et al. '712.

As discussed previously, Adams '552 does not teach or suggest a fastener with a passage formed through the conical end portion.

Therefore, Adams '552 in view of Whittaker et al. '712 fail to form a *prima facie* case of obviousness as required under 35 USC § 103(a). Accordingly, amended claim 21 is patentable

over Adams '552 in view of Whittaker et al. '712. Claim 26 depends on claim 21 for the same reason and is patentable for the same reason as claim 21.

Claim 27 depends on claim 1. Claim 1 includes the same feature as claims 21 and is patentable over Adams '552 in view of Whittaker et al. '712 for the same reason.

In item 8 of the Office action, the Examiner rejected claim 24 as being unpatentable over Adams '552 in view of Schwartz '159 and Hayhurst '330 under 35 USC § 103(a).

The invention according to amended claim 24 describes *inter alia* an implant including the following features:

a cylindrical body portion...;

a pointed end portion for piercing the body tissue ... being more rigid than the body tissue;

said cylindrical body portion having a first passage formed therein ...;

said cylindrical body portion having a second passage extending therethrough ...;

a suture connected to the cylindrical body ...; and

a retainer .... (Emphasis added by Applicant.)

None of the references, in particular Adams '552, teach or suggest a pointed end portion that is more rigid than the body tissue. Adams '552 teaches a deformable anchor (105). See col. 2, ll 50-52. According to Adams '552, the anchor 105 deforms as it pierces a gastro-intestinal wall.

In contrast to the prior art, the invention according to claim 24 describes an implant that is preferably inserted in bone tissue. The pointed end portion is made of a material that is more rigid than the body tissue in which it is being inserted. In this way, the implant can pierce the body tissue even when the body tissue is hard.

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Because the prior art does not teach or suggest all of the features of amended claim 24, the prior art fails to form a *prima facie* case of obviousness as is required under 35 USC § 103(a). Accordingly, the invention described by claim 24 is patentable.

In item 9 of the Office action, the Examiner rejected claim 25 as being unpatentable over Adams '552 in view of Schwartz '159, Hayhurst '330, and Egan '545 under 35 USC § 103(a). Claim 25 is dependent on claim 24 and is patentable over the art for the same reasons as claim 24.

In view of the foregoing, reconsideration and allowance of claims 1-3, 8, 10-21, and 24-26, 28, and 30-40 are now in the application. are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$65 in accordance with Section 1.17 is enclosed herewith.

A payment of \$286 is attached to provide for eleven extra total claims.

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No additional fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 782-A03-003-1).

Respectfully submitted,

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